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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763.331	01/26/2004	Sandy Chu	4444-0133P	6967

2292 7590 03/26/2007
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EXAMINER

DAM, KIM-LYNN

ART UNIT	PAPER NUMBER
2179	

2179

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/26/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/26/2007.

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mailroom@bskb.com

Office Action Summary

Application No.

10/763,331

Applicant(s)

CHU, SANDY

Examiner

Kim-Lynn Dam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 January 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
- Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- Notice of References Cited (PTO-892)
- Notice of Draftsperson's Patent Drawing Review (PTO-948)
- Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/22/04.
- Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- Notice of Informal Patent Application
- Other: _____

DETAILED ACTION

1. This office action is in response to the application filed on 1/26/04. Claims 1-27 have been examined and are pending. Claims 1 and 14 are independent.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-13 are non-statutory because they fail to provide a useful, concrete, and tangible result. Regarding claim 1, it merely calls for selecting, marking and adding without any further useful/practical result. It is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete." Furthermore, "If the specification discloses a practical application of section 101 judicial exception, but the claim is broader than the disclosure such that it does not require a practical application, then the claim must be rejected" – See MPEP 2106 (IV)(C).

Claims 2-13, do not remedy the deficiencies noted above, therefore are also rejected under the same rationale.

Claims 14-27 are directed to a system for effect addition in video edition, which amounts to software *per se*. Regarding claim 14, it merely calls for "importing model for... configuration model for... mark in model for... effect model for...", which amount to

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software *per se*. There are no computer components or statutory computer-readable media recited in the claims that would permit the functionality of the program development environment to be realized. Accordingly the claims are directed to non-statutory subject matter. See MPEP 2106.01.

Claims 15-27, do not remedy the deficiencies noted above, therefore are also rejected under the same rationale.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 13 recites the limitation "wherein said mark in point is adjusted" on lines 2 and 3 of the claim. There is insufficient antecedent basis for this limitation in the claim since lines 1 and 2 of the claim recites, "further comprising adjusting said effect duration of said mark in point". It is unclear whether the mark in point, or effect duration of the mark in point is adjusted. Applicant is advised to revise the claim to prevent ambiguity.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-10, 14-16, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Park (USPN 6,995,805).

Regarding claim 1, Applicant's own admitted prior art disclosed a method for effect addition in video edition, comprising:

selecting and arranging a plurality of clips, wherein said plurality of clips being arranged as a successive clip (Background, Page 2, lines 18-21; (Figure 1A);

making a plurality of mark in points of said plurality of clips (Background, Page 2, lines 21-22),

adding effects to said plurality of mark in points (Background, Page 1, lines 22 to Page 2, line 4).

Applicant's admitted prior art did not specifically disclose wherein said mark in points being made by using a scene scan. However, Park disclosed detecting and marking scene changes (Column 6, lines 35-46; Column 7, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Park with the video editing of the Applicant's admitted prior art since automatically scanning to mark detected scene changes is more efficient than manually making mark in points (Applicant's admitted prior art, Page 1, line 20 to Page 2, line 4).

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Regarding claim 2, the rejection of claim 1 is incorporated and further Applicant's prior art disclosed wherein said plurality of clips includes different formats (Page 2, lines 6-16).

Regarding claim 3, the rejection of claim 1 is incorporated and further Park disclosed wherein said mark in points are further made according to the joints between clips (Column 6, lines 35-46; Column 7, lines 40-45 (where joints between clips are a scene change)).

Regarding claim 4, the rejection of claim 1 is incorporated and further Park disclosed wherein said mark in points are further made according to where the scene information are (Column 6, lines 35-46; Column 7, lines 40-45 (where the point where scene information are is a scene change)).

Regarding claim 5, the rejection of claim 1 is incorporated and further Park disclosed wherein said scene information can be selected from the audio, graphic and text (Column 6, lines 35-46; Column 7, lines 40-45 (where the point of where audio, graphic and text are is a scene change)).

Regarding claim 6, the rejection of claim 1 is incorporated and further Park disclosed wherein scene scan is used to generate a scene scan sensitivity of each frame of said plurality of clips (Column 5, lines 17-29; Figure 1).

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Regarding claim 7, the rejection of claim 1 is incorporated and further Park disclosed wherein said plurality of mark in points are made by comparing said scene scan sensitivity with a scene scan sensitivity threshold (Column 5, lines 17-29; Figure 1; Column 2, lines 39-54).

Regarding claim 8, the rejection of claim 1 is incorporated and Applicant's admitted prior art disclosed further comprising making said mark in points manually by users (Background: Page 1, line 21-23; Page 2, lines 21-22).

Regarding claim 9, the rejection of claim 8 is incorporated and further Applicant's admitted prior art did not specifically disclose wherein said making said mark in points manually by users is before making said plurality of mark in points by using said scene scan. However Applicant's admitted prior art disclosed further comprising making said mark in points manually by users (Background: Page 1, line 21-23; Page 2, lines 21-22) and Park disclosed making said plurality of mark in points by using said scene scan (Background, Page 2, lines 21-22) or making said mark in points manually by users (Figure 1 (where method includes options for manual or auto detect)). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Park into the video editing of the Applicant's admitted prior art since automatically scanning to mark detected scene changes is more efficient than manually making mark in points for all the scenes (Applicant's admitted prior art, Page

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1, line 20 to Page 2, line 4). One of ordinary skill in the art would have found it motivated to have the option for users to manually make mark in points before using the scene scan since it would provide users with more flexibility and alternatives for making mark in points.

Regarding claim 10, the rejection of claim 1 is incorporated and further Park disclosed making said plurality of mark in points according to the recording time when said clip includes said recording time (Column 6, lines 35-46; Column 7, lines 40-45; Figure 1, element 140 (where recording time is where the scene changes).

Regarding claim 14, it is the corresponding system claim of claims 1 and 11. Therefore all the limitations in claim 14 have been addressed above and claim 14 is rejected under the same rationale.

Regarding claims 15, and 17-24, they are the corresponding system claims of claim 2 and 3-10. Therefore all the limitations of claims 3-13 have been addressed above, and claims 3-10 are rejected under the same rationale.

Regarding claim 16, the rejection of claim 14 is incorporated and further the Applicant's admitted prior art disclosed joining and integrating a plurality of clips to become an integrated clip (Figure 1A; Page 2, lines 18-21).

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7. Claims 11-13 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own admitted prior art in view of Park (USPN 6,995,805) as applied to claims 1-10 above, and further in view of Matsui et al. (USPN 6,674,955).

Regarding claim 11, the rejection of claim 1 is incorporated and neither Applicant's admitted prior art or Park specifically disclosed further comprising configuring an effect type and an effect duration for forming an effect, wherein said effects are added to said plurality of mark in points according to said effect type and said effect duration.

However, Matsui disclosed the above limitation (Figure 30; Column 41, lines 7-20). It would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teachings of Matsui into the video editing of the Applicant's prior art and system of Park since configuring an effect type and effect duration for effect addition would create better transitions resulting in a more harmonious integrated clip (Applicant's admitted prior art, Page 1, lines 14-18).

Regarding claim 12, the rejection of claim 11 is incorporated and neither Applicant's admitted prior art, Park, or Matsui expressly teach further comprising filtering out said mark in points, wherein said mark in point is filtered out when the range of the adding effect on said mark in point according to said effect type and said effect duration overlaps the range of another said mark in point and the scan order of said mark in point is later than said another mark in point. However, this limitation would have been obvious to one of ordinary skill in the art at the time the invention was made in view of

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Applicant's admitted prior art, Park and Matsui, because they teach the adding of effects to mark in points (See above rejections). The skilled artisan would determine that a mark in point could be filtered out when adding of an effect to that mark in point overlaps another mark in point, since creating a transition between the scene changes to reduce disharmony is the primary purpose of adding effects to those mark in points (Applicant's admitted prior art, Page 1, lines 14-18).

Regarding claim 13, the rejection of claim 11 is incorporated and neither Applicant's admitted prior art, Park, or Matsui expressly teach further comprising adjusting said effect duration of said mark in point, wherein said mark in point is adjusted when the range of the adding effect on said mark in point according to said effect type and said effect duration overlaps the range of another said mark in point and the scan order of said mark in point is later than said another mark in point. However, this limitation would have been obvious to one of ordinary skill in the art at the time the invention was made in view of Applicant's admitted prior art, Park and Matsui, because they teach the adding of effects to mark in points (See above rejections). The skilled artisan would determine that effect duration of a mark in point could be adjusted when adding of an effect to that mark in point overlaps another mark in point, since creating a transition between the scene changes to reduce disharmony is the primary purpose of adding effects to those mark in points (Applicant's admitted prior art, Page 1; lines 14-18).

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Regarding claims 25-27, they are the corresponding system claims of claims 11-13. Therefore, all the limitations of 11-13 have been addressed above, and claims 25-27 are rejected under the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim-Lynn Dam whose telephone number is (571) 270-1408. The examiner can normally be reached on M-TH 8:00-5:30, every other Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kim-Lynn Dam


BA HUYNH
PRIMARY EXAMINER